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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1949

NO._____

FAWCETT PUBLICATIONS, INC.,

Petitioner and Appellant below,

v.

BRONZE PUBLICATIONS, INC., and SAM B. SOLOMON,

Respondents and Appellees below.

PETITION FOR WRIT OF CERTIORARI

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Petitioner respectfully prays that a writ of certiorari issue to the United States Court of Appeals for the Fifth Circuit to review and reverse a decision rendered by said Court in the above entitled cause, affirming a judgment of the United States District Court for the Southern District of Florida.

I.

SUMMARY STATEMENT OF MATTER INVOLVED

Petitioner sued respondents for violation of the

Trade Mark Laws of the United States and for unfair competition between citizens of different states (R. 1).

Petitioner is the owner of registered trademark 163,-713 for "True Confessions" for magazines, registered under Act of 1905 on January 23, 1923. On October 27, 1942, said trademark was renewed to petitioner for a further period of twenty years (R. 2).

Petitioner and its founder have, since 1922, published the well-known magazine "TRUE CONFESSIONS." Petitioner has spent, for promotion and advertising of its said magazine "TRUE CONFESSIONS," a sum substantially in excess of One Million Dollars ($1,000,000) (R. 3, 4, 14, 20).

Petitioner's magazine "TRUE CONFESSIONS" has so gained in popularity that it ranks among the first ten magazines in the United States with respect to newsstand sales. The average monthly net paid circulation of petitioner's magazine "TRUE CONFESSIONS," at the time suit was instituted, was 1,700,000 copies per month. The word "Confessions" is the dominant feature of the title and trademark of petitioner's magazine and, because of the aforesaid wide distribution, it has come to be recognized by the trade and public as indentifying the origin and genuineness of petitioner's publication (R. 4, 5).

Respondents are newcomers in the field and began to publish a magazine under the title of "Bronze Confessions," whereon the word "Confessions" is prominently featured (R. 5).

The respondents, with intent to benefit by the repu-

tation of petitioner's said magazine "TRUE CONFESSIONS," and with full knowledge of and in disregard of the petitioner's rights, and without petitioner's consent or license, and intending unfairly and unnecessarily to profit by misusing and wrongfully appropriating the good will and reputation of petitioner and of petitioner's said name and trademark and to divert to the respondents a part of the demand for petitioner's said magazine and product, have commenced the publication of a magazine designed to appeal to readers of petitioner's magazine under the title "BRONZE CONFESSIONS," whereon the word "Confessions" is prominently featured on the front cover and contents page, and wherein the respondents have otherwise intentionally, unfairly and unlawfully adopted, imitated and copied petitioner's said magazine "TRUE CONFESSIONS."

The respondents' said use of the word "Confessions," and said other acts in imitation and copying of petitioner's said magazine, were conceived in bad faith, with full knowledge of petitioner's magazine and with intent to benefit from the good will built up by petitioner around the word "Confessions" as the dominant part of the title of petitioner's magazine and the good will in connection with other features in the petitioner's said magazine, to the damage and irreparable loss of the petitioner and injury to the public (R. 5, 6).

Petitioner believed that respondents' acts seriously damaged its business, diluted its good will, constituted unfair competition and infringed petitioner's rights, name and trademark, and accordingly sued as above stated (R. 6).

The answer of respondents did not deny and therefore in legal effect admitted the allegations of the complaint. Accordingly, petitioner moved for summary judgment (R. 9-12).

The District Court denied petitioner's motion for summary judgment and dismissed the petitioner's complaint (notwithstanding the fact that no cross-motion for summary judgment had been made by respondents), and held that the word "Confessions" was descriptive and not the subject of the protection accorded a valid registered trademark. On appeal, the Circuit Court of Appeals for the Fifth Circuit affirmed the District Court.

II.

JURISDICTION

Jurisdiction is invoked under Section 1254 (1) of the Judicial Code (28 U.S.C. 1254) and Rule 38 (5) (b) of the Supreme Court of the United States. The judgment of the District Court was affirmed by the Circuit Court of Appeals on April 12, 1949 (R. 37). A petition for rehearing was denied June 3, 1949 (R. 46). The mandate of the Circuit Court of Appeals was issued on and is dated June 17, 1949 (R.).

III.

QUESTIONS PRESENTED

1. Should the Court of Appeals for the Fifth Circuit have disregarded the provisions of the Lanham Trademark Act, which became effective July 5, 1947—prior to the institution of this lawsuit—and which provides that, though theretofore regarded as descriptive, a mark may

be registered when it has become distinctive of the applicant's goods in commerce, i. e., has acquired a secondary meaning; and which provides further that "proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce" for only five years is prima facie evidence that the mark has become distinctive? The petitioner shows such use of its mark in commerce for more than a quarter of a century.

2. Should the Court of Appeals for the Fifth Circuit have ignored the undisputed allegations of fact in the complaint and moving affidavit which allege and show the acquisition of a secondary meaning by petitioner in connection with the use of its mark for more than a quarter of a century and have affirmed a dismissal of the complaint as not stating a cause of action?

3. Should the Court of Appeals for the Fifth Circuit have permitted a judgment to stand in favor of the respondents on petitioner's motion for summary judgment, pursuant to Rule 56 of the Federal Rules of Civil Procedure, when respondents had not made any cross-motion for summary judgment?

IV.

REASONS RELIED ON FOR ALLOWANCE OF WRIT

1. The Circuit Court of Appeals has decided an important question of Federal Law, which has not been but should be settled by this Court.

2. The decision of the Circuit Court is in direct conflict with provisions of the recently enacted Lanham Trademark Act (see petition for rehearing, pages 5, 6, par. 6).

Thus:

(a) In holding that petitioner's mark was descriptive and had not become distinctive of the petitioner's magazines in commerce, the Circuit Court of Appeals ignored Title 15, Section 1052(f) of the United States Code, which provides that registration of a descriptive mark is permitted where such mark has acquired a secondary meaning and that the Commissioner may accept as sufficient evidence of such a mark having become distinctive, proof of substantially exclusive and continuous use as a mark by the applicant for only five years preceding the date of filing.

The uncontradicted allegations of fact in petitioner's complaint and moving affidavit showed a substantially exclusive and continuous use of petitioner's mark for more than twenty-five years before the commencement of the action.

(b) The Court below ignored the fact that the provisions of the Lanham Trademark Act create certain substantative property rights in owners of trademarks which did not exist prior thereto, as did the so-called ten year proviso of the Trademark Act of 1905 (Sec. 5, Trademark Act of 1905), which created a property right previously nonexistent when it permitted names registered thereunder to become valid technical trademarks.

Davids Co. v. Davids Mfg. Co., 233 U. S. 461

Armstrong Paint & Varnish Works v. Nu-Enamel Corporation, 305 U. S. 315, 335

The Lanham Trademark Act of 1946 (effective July 1947) was enacted because the prior Trademark Act of 1905 did not meet the requirements of modern commerce; and because the prior Act did not give sufficient protection to owners of trademarks or allow the registration of marks which had become valuable because of their association with the goods and products of their owners over a substantial period of time.

See:

In Re Canada Dry Ginger Ale, Inc., 86 Fed. (2d) 830, at p. 833

The New Trade Mark Manual by Daphne Robert—published by The Bureau of National Affairs, Inc., 1947—at pp. 53, 295

The ten year proviso under the 1905 Act was by the Lanham Act. in effect, reduced to five years, and the requirement of "exclusive" use in the 1905 Act was reduced to "substantially exclusive and continuous use." See:

Title 15, U. S. Code, Section 1052(f)

3. The decision of the Circuit Court is also in conflict with the decision in other Circuits on the construction of Rule 56 of the Federal Rules of Civil Procedure.

Recently, i.e., in October, 1948, Judge Harold R. Medina, a District Judge in the Second Circuit, rendered a decision in **Truncale v. Blumberg, et al.**, 8 F.R.D. 492, wherein he held that a summary judgment on the merits

may not be entered in favor of a party opposing a motion for summary judgment, in the absence of a cross-motion. This decision was rendered after the amendment to the Rules in March of 1948. Prior to the amendment there was a similar holding in **Pinkus v. Reilly**, 71 F. Supp. 993, in a District Court in New Jersey, in the Third Circuit. There has been a contrary holding in the Fifth Circuit in the case at bar, since respondents here made no cross-motion for summary judgment. Also, in **Hooker v. New York Life Ins. Co.**, 66 F. Supp. 313, D.C.N.D. Ill. (Seventh Circuit) entry of summary judgment was permitted despite absence of a cross-motion.

4. The decision of the Circuit Court, affirming the decision of the District Court granting summary judgment to respondents, even though no cross-motion was made therefor, involves an important question under the Federal Rules of Civil Procedure, which has not been but which should be settled by this Court.

The question is: Should District Courts grant summary judgment in favor of a party opposing a motion for summary judgment, in the absence of a cross-motion?

Rule 56 of the Federal Rules of Civil Procedure contains no express language permitting same. It has been argued in other cases that Rule 54(c) of the Federal Rules of Civil Procedure would permit such action. However, there is a sharp dispute between decisions of courts in the different Circuits in this regard.

This Court has the power to prescribe by general rules the forms of process, writs, pleadings and motions and the practice and procedure of the District Courts

of the United States in civil actions (Title 28, U.S.C., Sec. 2072). This Court, having the power to prescribe, likewise has the power to interpret and construe said rules and in a situation where courts in the different Circuits have construed differently Rule 56. This Court should decide this important question. In the case of **Sartor v. Arkansas Nat. Gas Corp.**, 321 U.S. 620, this Court did, on a writ of certiorari to the United States Circuit Court of Appeals, Fifth Circuit, review a judgment affirming a judgment of the District Court which dealt with an application of Rule 56 relating to summary judgment, and reversed the lower courts.

5. The question involved in the action is of great importance to both the business world and legal profession.

Owners of marks, for which millions of dollars are spent in promotion, exploitation, advertising and publicizing, should have a decision from this Court advising them that where they have a mark which has been in substantially exclusive and continuous use for a period of five years and more, though regarded by some as descriptive, it is entitled to registration; and, being entitled to registration, it is also entitled to trademark protection. This case typifies the great importance to the business world of knowing whether there can be acquired a substantive property right in a descriptive mark which has become distinctive of goods in commerce by reason of substantially exclusive and continuous use under the provisions of the Lanham Trademark Act.

The legal profession would likewise benefit by a decision from this Court on this highly important ques-

tion arising under this recently enacted statute.

WHEREFORE, it is respectfully submitted that this petition for a writ of certiorari, to review the judgment of the Court of Appeals for the Fifth Circuit be granted.

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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1949

NO._____

FAWCETT PUBLICATIONS, INC.,

Petitioner,

v.

BRONZE PUBLICATIONS, INC., and SAM B. SOLOMON,

Respondents.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Petitioner believes that a writ of certiorari should be granted in this case for the reasons referred to in the petition and hereinafter set forth.

THE OPINIONS OF THE COURT BELOW

The opinion of John W. Holland, United States District Judge, is not reported (R. 22).

The original opinion of the Circuit Court of Appeals is reported at 173 F. 2d 778 and appears in the record at R. 22. The judgment entered upon the appeal appears

at R. 38. The petition for rehearing (R. 45) was denied with opinion on June 3, 1949 (R. 46). For the Court's convenience copies of the opinions of the Circuit Court of Appeals are set forth in an appendix to this brief.

JURISDICTION

As noted in the petition, jurisdiction is invoked under Title 28 U.S.C., Sec. 1254(1).

Certiorari to this Court lies in trademark cases.

Mishawaka R & W Mfg. Co. v. S. S. Kresge Co., 316 U.S. 203

It is specifically provided in the Lanham Trademark Act that writs of certiorari may be granted by the Supreme Court of the United States for review of cases arising thereunder.

See:

15 U.S.C., Sec. 1122

STATEMENT OF FACTS

The essential facts are set forth in the petition.

SPECIFICATION OF ERRORS TO BE URGED

The Circuit Court of Appeals erred:

1. In disregarding the provisions of the Lanham Trademark Act, i.e., 15 U.S.C. 1052(f), and in effect

ruling it was the intention of Congress, when it enacted the Lanham Act prior to the commencement of this lawsuit, to authorize a barren registration of a descriptive mark which conferred no rights on the owner.

2. In holding that the petitioner's mark was not a valid trademark and subject to trademark protection when the fact remains that petitioner's mark was registered under the Act of 1905 and renewed by the United States Patent Office for a further period of twenty years in October, 1942, and by the provisions of the Lanham Act entitled to its benefits.

3. In refusing to grant summary judgment in favor of petitioner when the answer of the respondents contained no denials of the material allegations of the complaint and no denial was made of the allegations of petitioner's moving affidavit.

4. In holding that the word "Confessions" had not acquired a secondary meaning as applied to petitioner's magazine, when the undisputed allegations of the complaint and moving affidavit show that for more than a quarter of a century petitioner has used substantially exclusively and continuously the word "Confessions" as the dominant part of the title and trademark of its magazine.

5. In granting summary judgment in favor of the respondents, and dismissing the petitioner's complaint as not stating a cause of action, when the respondents had not made any cross-motion for summary judgment under Rule 56 of the Federal Rules of Civil Procedure.

ARGUMENT

SUMMARY OF THE ARGUMENT

Point A

THE DECISION OF THE CIRCUIT COURT IS IN DIRECT CONFLICT WITH AND IN DISREGARD OF THE PROVISIONS OF THE LANHAM TRADEMARK ACT.

The Court below has failed to take cognizance of the provisions of the recently enacted Lanham Trademark Act. The Lanham Trademark Act became effective July 5, 1947, prior to the institution of this lawsuit. It was particularly called to the attention of the Court below on petition for rehearing that this newly enacted Trademark Act provided (at 15 U.S.C., Section 1052) as follows:

> "No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—
>
> * * *
>
> (e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when applied to the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, or (3) is primarily merely a surname.

(f) Except as expressly excluded in subsections (a), (b), (c), and (d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration."

(Petition for rehearing, pages 5-6)

It is to be noted that under this new Trademark Act, a descriptive mark may be registered when it has become distinctive of the applicant's goods in commerce. It is further provided that the Commissioner may accept as sufficient "proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce" for only five years. Petitioner in the complaint alleged and in the moving affidavit furnished proof that it had acquired a secondary meaning and, in addition, showed that it had used the mark on its magazine for more than a quarter of a century. These allegations were undenied and the proof so furnished by petitioner was uncontradicted (R. 3, 4, 5; 9-12; 14, 20).

This new Trademark Act was enacted because the prior Act did not give sufficient protection to owners of trademarks and did not allow registration of many descriptive marks which had become valuable because of their long association with the goods and products of their

owners, except those qualifying under the so-called "ten year proviso" (Section 5, Trademark Act of 1905). This proviso created a property right in an owner which was previously non-existent, since it permitted an applicant to register a mark which was in **exclusive** use as a trademark for ten years prior to the enactment of the Trademark Act of 1905.

See:

Davids Co. v. Davids Mfg. Co., 233 U.S. 461

Armstrong Paint & Varnish Works v. Nu-Enamel Corporation, 305 U.S. 315

In **Armstrong Paint & Varnish Works v. Nu-Enamel**, supra, this Court stated at page 335:

> "It was said in Thaddeus Davids Co. v. Davids Mfg. Co. that names registered under the last proviso of Sec. 5 of the 1905 act became technically trademarks upon valid registration under that act. * * * "

Under the Lanham Trademark Act the period of use was in effect reduced to five years and now the trademark owner need only show "substantially" exclusive and continuous use.

The New Trade-Mark Manual by Daphne Robert, pages 53, 295

In The New Trade-Mark Manual by Daphne Robert, supra, the author states at page 53:

"* * * The effect of the language of Section 2(f) of the new Act, is to say that descriptive words, geographical names and surnames which have become identification marks of a particular product or service of a particular person are no longer 'merely descriptive', 'merely geographically descriptive', or 'primarily merely a surname'. Through substantially exclusive use, they can become valid trade-marks registerable under the Act."

It is also provided in the Lanham Act, in Section 46(b) thereof (See 15 U.S. Code Annotated, Section 1051, footnote; The New Trade-Mark Manual by Daphne Robert, page 263) that registrations under the Act of February 20, 1905 are subject to and entitled to the benefits and provisions of the Lanham Act to the same extent and with the same force and effect as though registered on the principal register established by the Act, except as limited in certain Sections not applicable to the case at bar.

Accordingly, petitioner in the action at bar, having shown that "True Confessions" had become an identification mark for its product, and having a mark which has been duly registered under the Act of 1905 and which had already been renewed by the United States Patent Office, the Court below, we respectfully submit, should have held that, in accordance with the provisions of the Lanham Trademark Act, petitioner had a good and valid trademark entitled to protection.

Point B

THE DECISION OF THE CIRCUIT COURT IS IN CONFLICT WITH THE DECISIONS IN OTHER CIRCUITS ON CONSTRUCTION OF

RULE 56 OF THE FEDERAL RULES OF CIVIL PROCEDURE.

In the present action petitioner moved for summary judgment by reason of the fact that the answer of the respondents contained no denial of the material allegations of fact in the complaint. Upon the motion the complaint was supported by an affidavit of one of petitioner's officers. Accordingly, if the complaint stated a cause of action, petitioner was entitled to judgment, or at least an opportunity to offer oral testimony to prove the facts alleged in its complaint and moving affidavit upon a trial. The respondents made no cross-motion for summary judgment and submitted no papers in opposition to petitioner's motion, except their unverified answer (R. 9-12; 30-32).

Rule 56 contains no express language permitting a Judge hearing a motion for summary judgment to award judgment for the opposing party when no cross-motion has been made therefor.

In the case of **Truncale v. Blumberg, et al.**, S.D.N.Y., October 1948, 8 Federal Rules Decisions 492, the Court, per Medina, J., stated at pages 492-493:

> "While it is my personal preference that the summary judgment rule be made as flexible and expeditious as possible, so that the full potentialities of this procedural device may be realized, I cannot persuade myself that Rule 56 was intended to permit an adjudication on the merits favorable to the party opposing a motion for summary judgment, without a cross-motion. This view is confirmed by the circumstance

that this very question of the necessity for a cross-motion received thoughtful consideration by the Advisory Committee at the time of the formulation of the amendments, which took effect in March of this year. The decision by the Advisory Committee that no change should be made, would seem to be a clear indication that such relief should not now be granted in the absence of a cross-motion. After all, there will in most cases be little delay and no substantial inconvenience if the cross-motion is required."

To the same effect see:

Pinkus v. Reilly, 71 F. Supp. 993 (a N. J. District Court decision in the Third Circuit)

Decisions by courts in other Circuits have been to the contrary.

Hooker v. New York Life Ins. Co., D.C.N.D. Ill. 1946, 66 F. Supp. 313, at p. 318

It is to be noted that Judge Medina in the **Truncale v. Blumberg** case refers to the consideration given by the Advisory Committee at the time of the formulation of the amendments to the Rules and notes that they decided no change should be made which indicated that relief should not be granted where the opposing party fails to make a cross-motion for summary judgment.

Since the notes of the Advisory Committee were apparently prepared before the final draft was submitted to the Supreme Court and were before the Court when it considered the rules and the amendments thereto, it

seems that they may properly be given weight in determining this Court's intention in adopting a particular rule. The notes have been so used in different Circuits. For example see:

Brown v. Beckham, 50 F. Supp. 313, at p. 316

Food Machinery v. Guignard, 26 F. Supp. 1002

It is respectfully submitted that this Court should resolve this conflict, as it exists in the decisions of the various Courts, in connection with the interpretation and construction of Rule 56 of the Federal Rules of Civil Procedure.

In view of the fact that this question of procedure has never before been passed upon by this Court, so far as we have been able to ascertain, and has not been provided for in the original Rule 56 or in any of the amendments thereto, and since the Rule has been in effect for a number of years, and due to the conflict of the decisions of the various courts as hereinabove referred to in connection with the interpretation and application of this problem of procedure, it seems fitting that this Court should at this time settle this all-important question.

Point C

THE QUESTION INVOLVED IN THIS ACTION IS OF GREAT IMPORTANCE TO BOTH THE BUSINESS WORLD AND LEGAL PROFESSION.

See petition, pages 7, 8.

It is therefore respectfully submitted that this case is one calling for the exercise by this Court of its supervisory powers, by granting a writ of certiorari and thereafter reviewing and reversing said decision.

Respectfully submitted,

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APPENDIX

IN THE UNITED STATES COURT OF APPEALS
FIFTH CIRCUIT

No. 12478

FAWCETT PUBLICATIONS, INC.,

Appellant,

versus

BRONZE PUBLICATIONS, INC., ET AL.,

Appellees.

Appeal from the District Court of the United States for the Southern District of Florida.

(April 12, 1949.)

Before SIBLEY, McCORD, and WALLER, Circuit Judges.

McCORD, Circuit Judge: This suit was brought by Fawcett Publications, Inc., a Delaware Corporation, against Bronze Publications, Inc., a Florida Corporation, and Sam B. Solomon, defendants, for unfair competition

and alleged infringement of a registered trade mark belonging to plaintiff, known as "True Confessions".

The complaint alleges that plaintiff and its founder and predecessor have continuously, since the year 1922, been engaged in publishing, distributing and selling magazines, one of plaintiff's most popular publications being a monthly magazine called "True Confessions"; that since it was incorporated in 1924 plaintiff has been the owner of the trade mark, "True Confessions", and has used same to designate its monthly publication almost continuously since that time; that through industry and the expenditure of large sums of money in advertising, plaintiff has built up a valuable and successful publishing business and created much good will; that one of its most valued assets is its "True Confessions" magazine, which has through many years received a wide publication and enjoyed a constantly increasing circulation throughout the United States and foreign countries; that one of the principal channels for the distribution and sale of this magazine is through newsdealers and their news stands throughout this country and elsewhere, and that this magazine and other publications are displayed and sold from these news stands and racks by news dealers who make them available to public view and inspection. It is then alleged that the word "Confessions" has been so prominently displayed as the dominant feature of the title and trade mark of plaintiff's magazine that it has come to be recognized by the trade and public through many years as identifying the origin and genuineness of plaintiff's publication, "True Confessions"; that defendants, with intent to benefit from the reputation and good will rightfully accruing to plaintiff's magazine, and to profit unfairly by approriating plaintiff's name and trade

mark to their own use and thereby divert a part of the demand for plaintiff's magazine to their publication, are publishing a similar magazine entitled "Bronze Confessions", whereon the word "Confessions" is prominently featured on the front cover and the contents page, and wherein defendants have imitated plaintiff's publication, to its damage. Plaintiff prays for an injunction against the further publication and sale of defendants' magazine, and against the alleged infringement of its trade mark and unfair competition resulting from the use of the word, "Confessions," as exhibited and printed thereon.

Defendants, in substance, answered that (1) the word, "Confessions" is a mere descriptive word, and plaintiff could acquire no exclusive right to its use as a trade mark; (2) there could be no infringement or unfair competition because of the use of the name "Bronze", as opposed to "True", in connection with the word "Confessions," and that the general appearance and text of the two magazines, as well as the type of illustrations and stories contained therein, were so different as to render them clearly distinguishable from each other, and to make any deception or confusion of the public from the sale of both magazines practically impossible; (3) defendants' magazine, "Bronze Confessions", is designed and published principally to appeal to negro buyers, as negro writers, subjects and illustrations are used exclusively therein, whereas plaintiff's publication is designed and published principally to appeal to white people; and (4) that trade mark registrations had been issued for several magazines other than defendants' publication, in which the word "Confessions" was contained in the title of each, and that the United States Patent Office had granted no

exclusive use of the word "Confessions" to the plaintiff or any one else.

Upon the filing of the answer, plaintiff moved for a summary judgment under Rule 56, Federal Rules of Civil Procedure, which motion was denied by the trial court. Plaintiff thereafter declined to amend its complaint with leave of the court, whereupon judgment was entered dismissing the suit for failure to state a claim upon which relief could be granted.

We are of opinion the trial court properly held that the word "Confessions" is a mere descriptive or generic term, and that plaintiff's trade mark, "True Confessions," did not contemplate or grant any exclusive right to the use of its component word, "Confessions," there being no deception or fraud of the public shown. 15 USCA Sec. 1052, et seq.; **Wilhartz v. Turco Products, Inc.**, 164 F. 2d 731; **Pulitzer Publishing Co. v. Houston Publishing Co.**, 11 F. 2d 834; **McGraw-Hill Publishing Co., Inc., v. American Aviation Associates, Inc.**, 117 F. 2d 293; **Dryice Corp. of America v. Louisiana Dry Ice Corp.**, 54 F. 2d 882.

A careful comparison of the two publications which are before us as exhibits in this case logically impels the conclusion that neither magazine could reasonably be confused with nor mistaken for the other, any more than the magazine, "Negro Digest", could be accepted for "Readers Digest." The publication, "Bronze Confessions," purports on its cover to contain "True stories of Negro love and romance," and both the illustrations and stories therein appear to be drawn and written to appeal to the Negro race. It is practically impossible to conceive how regular buyers or subscribers to the magazine, "True Confessions," which is manifestly designed to appeal prin-

cipally to white readers, could be deceived or misled into purchasing the defendants' magazine, "Bronze Confessions," while under the impression they were buying the magazine published by plaintiff. Nor does it appear probable or likely that the public could ever be so deceived, so long as the two publications remain so dissimilar in general cover appearance and text. It is well settled that where, as here, no exclusive right to the use of a trade mark exists, some fraud or deception in the use of a similar mark by another must be intended, in order to warrant injunctive relief. **Kellogg Co. v. National Biscuit Co.**, 305 U.S. 111; **Fawcett Publications, Inc. v. Popular Mechanics Co.**, 80 F. 2d 194; **Pure Oil Co. v. The Pep Boys - Manny, Moe & Jack**, 128 F. 2d 34; **Fidelity Bond & Mortgage Co. v. Fidelity Bond & Mortgage Co. of Texas**, 37 F. 2d 99.

The complaint here, even when considered in the light of the exhibits and affidavit introduced in support thereof, further fails to establish any right to relief on the alternative ground of unfair competition. The magazine published by defendants does not presume any connection whatever with that of plaintiff, and it is not shown that defendants have actually sold or threatened the sale of their magazine in such manner as to constitute an unfair competitive practice. **Beneficial Industrial Loan Corp. v. L. G. Allenstein**, CA 5, decided March 8, 1949, ...F. 2d .....; Cf. **Fawcett Publications, Inc. v. Popular Mechanics Co.**, 80 F. 2d 194. Moreover, it is not shown that the word, "Confessions," has acquired a secondary meaning which could reasonably be regarded as identifying only plaintiff's publication, "True Confessions." To the contrary, it appears that plaintiff has itself obtained trade mark registrations for at least three other erstwhile proposed publications, with the word "Confessions" appearing in

the title of each. This fact, even though the magazines were never published, at least evidences an intention on the part of both plaintiff and the Patent Office not to restrict the use of the word solely to the plaintiff's initial "Confessions" magazine. It further appears that other magazines bearing the disputed word in their titles have been published and attained some degree of circulation through the years, although, largely through plaintiff's efforts, most of them have enjoyed no sustained existence. We conclude that plaintiff's magazine has not acquired any such secondary significance as would entitle it to monopolize the exclusive use of the word "Confessions" as a part of its title. **Beneficial Industrial Loan Corp. v. L. G. Allenstein,** CA 5, decided March 8, 1949, ... F. 2d .....; **McGraw-Hill Publishing Co. v. American Aviation Associates, Inc.,** 117 F. 2d 293.

We consider the cases of **Crime Confessions, Inc. v. Fawcett Publications, Inc.,** 139 F. 2d 499, and particularly **Fawcett Publications v. Popular Mechanics Co.,** 80 F. 2d 194, as readily distinguishable under their own facts, and the principles therein enunciated are not in conflict with our decision, or controlling in favor of appellant here.

We find no reversible error in the record, and the judgment is accordingly

AFFIRMED.

A True copy:
Teste:

OAKLEY F. DODD,
Clerk of the United States Court of Appeals for the Fifth Circuit.

(June 3, 1949)

ON PETITION FOR REHEARING

Before SIBLEY, McCORD and WALLER,
Circuit Judges.

BY THE COURT: Appellant now complains that this court erred in its original opinion in concluding that it had itself obtained trade mark registrations for at least three other proposed publications, with the word "Confessions" appearing in the title of each. We have accordingly re-examined the record, and find that two of the other "Confessions" magazines have been registered and published in years past by a competitor of appellant, McFadden Publications, and that the third, "Mystic Confessions," was registered and published by a wholly owned subsidiary of appellant during the year 1938. We, therefore, adhere to our original opinion, as it sufficiently appears from the pleadings and exhibits in the case that the word, "Confessions," is merely descriptive of a class of popular monthly publications, and has acquired no secondary meaning as identifying only plaintiff's publication, "True Confessions." Cf. **Crime Confessions, Inc. v. Fawcett Publications, Inc.**, 139 F. 2d 499. The petition for hearing is DENIED.

A true copy:
Teste:

OAKLEY F. DODD,
Clerk of the United States Court of
Appeals for the Fifth Circuit.